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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/522,753	03/10/2000	Ronald M. Evans	SALK1510-3	4924

7590

09/10/2002

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EXAMINER

LOEB, BRONWEN

ART UNIT	PAPER NUMBER
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1636

DATE MAILED: 09/10/2002

22

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/522,753

Applicant(s)

EVANS ET AL.

Examiner

Bronwen M. Loeb

Art Unit

1636

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 03 September 2002 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.


Claim(s) rejected: 1 and 3-25.

Claim(s) withdrawn from consideration: 26-37.

8. ☒ The proposed drawing correction filed on 03 September 2002 is a) ☐ approved or b) ☒ disapproved by the Examiner.

9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.

10. ☐ Other: _____


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Continuation of 2. NOTE: While the proposed amendment would lead to the withdrawal of the rejection of claims 1, 3, 5, 8 and 11 under 35 USC §112, first paragraph for lack of written description, claim 6 would remain rejected as it recites "isoform or peptide portion thereof" for which there is insufficient written description in the specification for reasons of record. Amended claims 19-22 would be rejected under 35 USC §112, first paragraph for insufficient written description for the same reasons as claim 4. Furthermore, Applicant has also amended claims 4, 9, 12 and 14 to also recite "isoform or peptide portion thereof" language for which the specification lacks sufficient written description; claim 14 would therefore now be subject to a rejection under 35 USC §112, first paragraph for insufficient written description. Applicant's arguments regarding "hybridizes under stringent conditions" and "conservative variants" are essentially the same as those presented before and remain unpersuasive for reasons of record, therefore the related rejections are maintained. Thus, there is no material reduction in the issues for appeal and in fact, there would be a new grounds of rejection for claim 14. Furthermore the proposed amendments to claim 14 and 16 raise the possibility of a new rejection under 35 USC §112, second paragraph. Claim 14 appears to refer to two different polynucleotides as "a polynucleotide" rendering the metes and bounds of the claim unclear; furthermore, this creates an antecedent basis problem for the phrase "said polynucleotide" in claim 16.

Continuation of 8. NOTE: The submitted drawings (Figures 5A and 9) remain illegible, quite possibly due to being faxed. It is suggested that Applicant state on the record that he agrees to submit completely legible drawings once allowable subject matter is indicated. Such a statement would be considered responsive to the drawing objection made by the Examiner.